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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,798	12/12/2003	Rema Ananthanarayanan	JP920030082US1	3886
T. Rao Coca IBM Corporation Almaden Research Center 650 Harry Road San Jose, CA 95120			EXAMINER VEZERIS, JAMES A	
			ART UNIT 3693	PAPER NUMBER
			MAIL DATE 05/14/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/734,798

**Applicant(s)**

ANANTHANARAYANAN ET AL.

**Examiner**

JAMES A. VEZERIS

**Art Unit**

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF 298)  
Paper No(s)/Mail Date \_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

### **Final Action**

#### **Response to Arguments**

1. Applicant's arguments with respect to claims 1, 5, 6, 7, 11, 12, and 15-17 have been considered but are moot in view of the new ground(s) of rejection. Examiner notes all arguments were based off of the amended claims.

#### **Detailed Action**

#### **Claim Objections**

2. Claims 2, 3, 4, 8-10, 13, and 14 are objected to because of the following informalities: The preamble states, "all the limitations of which are incorporated herein by reference," which is not limiting to the claim. Appropriate correction is required.

#### **Claim Rejections- 35 U.S.C. 103(a)**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Art Unit: 3693

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over PG-Pub 2002/0111896 to Ben-Levy et al. (Hereinafter "Ben") in view of US Patent 5615269 to Micali (Hereinafter "Micali").

**Regarding Claims 1, 5-7, 11, 12, and 15-17.**

Ben teaches a method of trading goods and services in an online market, the online market comprising a user and a plurality of trading parties, each trading party trying to strike a trading deal with the user, the user specifying initial requirements for initiating trading in the online market, the method comprising: (examiner notes that the auction of a bond or security can be construed as a good and a service, in the case of a bond it is a loan to a company)

executing a trading mechanism to arrive at trading offers, the trading offers being submitted by the trading parties based on the initial requirements of the user; (See paragraph 87)

selecting a first trading offer from the trading offers; (See Paragraph 106, 107)

Ben further teaches if a first trading offer is not selected, Ben fails to invoke standalone bilateral negotiations, which stand apart from the trading mechanism, to arrive at customized trading offers, the standalone bilateral negotiations being invoked with the trading parties who submitted trading offers;

Micali however teaches invoking standalone bilateral negotiations, which stand apart from the trading mechanism, to arrive at customized trading offers, the standalone bilateral negotiations being invoked with the trading parties who submitted trading offers; (Micali Col 2 Lines 5-49)

repeating said executing, and either said selecting or said invoking to obtain either said attractive and feasible trading offer or said customized trading offers, respectively; (Micali Col 2 Lines 5-49)

evaluating the attractive and feasible offer or the customized trading offers by a utility function based on multiple attributes of a traded good or a traded service, user-specified weights associated with the traded good or the traded service, and user-specified costs associated with the multiple attributes of the traded good or the traded service; (Micali Col 2 Lines 5-49)

Ben further teaches concluding trading deals based on the evaluated attractive and feasible offer or the customized trading offers, whereby said trading mechanism and said standalone bilateral negotiations are combined. (p. 114)

It would be obvious to one skilled in the art at the time of the invention to combine Ben with Micali.

There is motivation to do so because negotiation a trade price is essential to completing a transaction, and a stand alone negotiation allows for no inside influence on the negotiation process.

All claims listed above are rejected for analogous reasoning.

**Regarding Claims 2, 9, and 13.**

Ben fails to further teach invoking the standalone bilateral negotiations comprises:

- agreeing upon a protocol for conducting the standalone negotiations;
- exchanging offers as per the agreed upon protocol;
- concluding the standalone negotiations as per the agreed upon protocol.

Micali does teach agreeing upon a protocol for conducting the standalone negotiations; (See Col. 2 Lines 5-49)

- exchanging offers as per the agreed upon protocol; (See Col. 2 Lines 5-49)
- concluding the standalone negotiations as per the agreed upon protocol. (See Col. 2 Lines 5-49)

It would be obvious to one skilled in the art at the time of the invention to combine Ben with Micali.

There is motivation to do so because negotiation a trade price is essential to completing a transaction, and a stand alone negotiation allows for no inside influence on the negotiation process.

**Regarding Claims 3, 10, and 14.**

Ben further teaches all the limitations of which are incorporated herein by reference, wherein the exchanging offers comprises:

- receiving offers from the trading parties; (See p. 106 and 107)
- evaluating the received offers; (See p. 108, 111)
- generating counter-offers on the basis of evaluated offers; (See p. 105, 108)

sending counter-offers to the trading parties; (See p. 105, 108)

repeating said receiving, said evaluating, said generating and said sending in accordance with the agreed upon protocol. (See p. 105, 106, 107, 108, and 111)

**Regarding Claim 4.**

Ben further teaches all the limitations of which are incorporated herein by reference, wherein the online market is a regulated online market, the online market being regulated to increase trading efficiency of the online market, the trading efficiency of the online market being governed by the number of trading parties that strike a trading deal. (See p. 80-84)

**Regarding Claim 8.**

Ben further teaches all the limitations of which are incorporated herein by reference, wherein the server further comprises:

a repository containing information related to the initial requirements of trading parties; (See p. 43)

a repository containing information related to past trading deals; (See p. 43)

a repository containing information related to the trading parties.(See p. 43)

### **Conclusion**

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES A. VEZERIS whose telephone number is (571)270-1580. The examiner can normally be reached on Monday-alt. Fridays 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3693

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/  
Supervisory Patent Examiner, Art Unit 3693

/JAMES A VEZERIS/  
Examiner, Art Unit 3693

5/7/2008